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REMARKS

Pending Claims

Claims 32 and 33 have been cancelled without prejudice to filing the subject matter of these claims in one or more subsequent applications or to reintroduction in the present application. Also, claims 8, 9, 21, and 29, which had depended directly from claim 32, have been amended to depend from claim 40, and claims 34 and 39, which had depended directly from claim 33, have been amended to depend from claim 41. No new matter has been added. Thus, claims 8-10, 12-19, 21-25, 29, and 34-41 are pending.

Reconsideration and continued examination of the above-identified application are respectfully requested. No search is necessitated by the amendment described above and no new questions of patentability should arise, since the scope of this subject matter has already been examined by the Examiner. No new matter has been added. Finally this amendment places the application in condition for allowance. Therefore, entry of this amendment is respectfully requested.

Rejection under 35 U.S.C. § 112, Second Paragraph

In paragraph 1, the Final Office Action states that the rejection of claims 8-10, 12-19, 21-25, 29, and 32-39 under 35 U.S.C. § 112, second paragraph, has been maintained.

In particular, in paragraph 3, the Final Office Action states that, while Applicants have argued that the use of the expression "comprising" does not create any ambiguity to the metes and bounds of the attached group which contains the specifically recited elements, this expression is still vague and indefinite since the term "comprising" means that the organic ionic group may contain additional components, leaving open the inclusion of unspecified ingredients even in major amounts.

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Applicant continues to strongly disagree with the rejection of the present claims for the use of the term "comprising", which is a well understood transitional phrase that is acceptable according to the MPEP (2111.03). However, in order to advance the prosecution of this application and place it in condition for allowance, Applicant has cancelled claims 32 and 33 without prejudice to filing the subject matter of these claims in one or more subsequent applications or to reintroduction in the present application, thus making the rejection of these claims moot. Furthermore, claims 8, 9, 21, and 29, which had depended directly from claim 32, have been amended to depend from claim 40, and claims 34 and 39, which had depended directly from claim 33, have been amended to depend from claim 41. Thus, claims 8-10, 12-19, 21-25, and 29 depend directly or indirectly from claim 40, and claims 34-39 depend directly or indirectly from claim 41. Since claims 40 and 41 do not recite the term "comprising" and, as a result, have not been included in the current rejection under 35 U.S.C. § 112, second paragraph, Applicant therefore believes that the present claims are in condition for allowance and respectfully request that the rejection of claims 8-10, 12-19, 21-25, 29 and 32-39 under 35 U.S.C. § 112, second paragraph be withdrawn.

Double Patenting

On page 3, the Final Office Action states that claims 40-41 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 99, 101, and 111 of copending U.S. Patent Application No. 11/709,630, adding that, while the conflicting claims are not identical, they are not patentably distinct from each other because they are related to each other as a genus and species.

In particular, the Final Office Action states that, when the present invention and the copending application are compared, there is overlap among the variables such as -X-Sp-[A]_pR in addition to the similarity between the names of the desired products (a black matrix versus a carbon black product). The Final Office therefore concludes that it would have been obvious

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to the skilled artisan in the art to be motivated to broaden the claimed invention by adding the formula of the organic groups in order to expand the coverage of the claimed invention.

Applicant respectfully disagrees. As noted in the Final Office Action, claims 99, 101, and 111 of copending U.S. Patent Application No. 11/709,630 recite a black matrix while present claims 40 and 41 each recite a carbon black product. These are not similar products. In particular, a black matrix is a component of an image display, such as a liquid crystal display (LCD), which is formed by applying a photosensitive coating on a clear substrate, exposing the coating imagewise, and developing and drying the coating. Clearly this is not a carbon black product, as the term is used in the present claims.

Furthermore, present claims 40 and 41 each recite a carbon black product having two different types of attached groups – at least one specified steric group and at least one aromatic or C1-C12 alkyl group further substituted with at least one specific ionic group with at least one amphiphilic counterion. By comparison, claim 111 of copending U.S. Patent Application No. 11/709,630 recites a black matrix comprising a) a pigment having attached at least one organic ionic group and at least one amphiphilic counterion or b) a pigment having attached at least one organic group represented by specific formulas, including $-X-Sp-[A]pR$. There are no claims of this copending application which recites both of the attached groups recited in present claims 40 and 41.

Since the claimed products are different and since the claimed types of attached groups are different, Applicants therefore believe that present claims 40 and 41 are patentably distinct from the claims of copending U.S. Patent Application No. 11/709,630.

Furthermore, as noted by the Examiner on page 6 of the Final Office Action, this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicant therefore believes it would be best to permit the present application to issue into a patent and to address this rejection when U.S. Patent Application No. 11/709,630 is further examined, or vice versa. The undersigned notes that this is acceptable under the guidelines set forth in the MPEP, particularly when this provisional double patenting rejection is the only remaining rejection (see MPEP 804.I.B.).

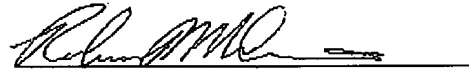
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Conclusions

In view of the foregoing amendments and remarks, Applicant believes that this application is in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would further expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

Respectfully submitted,

By:



Dr. Robert M. Amici
Reg No. 52,554
CABOT CORPORATION
Law Department
157 Concord Road
Billerica, MA 01821-7001
(978)-670-6191

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